



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,134	12/20/2001	Parris S. Wellman	102863-0017	4419

21125 7590 05/18/2006

NUTTER MCCLENNEN & FISH LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02210-2604

EXAMINER

ROANE, AARON F

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,134	WELLMAN ET AL.	
	Examiner	Art Unit	
	Aaron Roane	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3739

DETAILED ACTION

Reopen Prosecution

In view of the Appeal Brief filed on 2/27/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Linda Dvorak

*Eleni Manfrollo, SPE
Signing for Linda Dvorak*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 7, 8, 10, 13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Tetzlaff et al. (USPN 6,511,480 B1).

Regarding claims 1 and 13, Tetzlaff et al. disclose a surgical ablation instrument, comprising: a first member (280) having a first tissue-contacting conductive element (exposed portion of 280 used for engaging tissue along with the corresponding portion on 282) with a substantially circular shape extending along a length thereof (see the longitudinal profile of the jaw 280 in figures 12-14), the first tissue-contacting conductive element being in communication with a source of ablative energy (see element 262 and

Art Unit: 3739

col. 11, lines 1-25); and a second member (282) having a second tissue-contacting conductive element (exposed portion of 282 used for engaging tissue along with the corresponding portion on 280) with a substantially circular shape extending along a length thereof, the second tissue-contacting conductive element being in communication with a source of ablative energy, and the second member being pivotally coupled (303 and 305) to the first member and including a distal, tissue-piercing tip (distal tips of 280 and 282) adapted to be deployed into tissue to allow the first conductive element to be positioned on a first tissue surface and the second conductive element to be positioned on a second tissue surface opposed to the first tissue surface such that ablative energy can be transmitted between the first and second conductive elements, see col. 1-132, particularly, col. 10, line 36 through col. 13, line 43 and figures 1-14, particularly figures 12-14.

Regarding claims 2, 7 and 8, Tetzlaff et al. further disclose the first and second members are movable between a first, open position and a second, closed position in which the first member is adjacent to the second member, see col. 1-132, particularly, col. 10, line 36 through col. 13, line 43 and figures 1-14, particularly figures 12-14.

Regarding claims 3, 11 and 15, Tetzlaff et al. further disclose an actuating member (collectively 220 and 228a) mated to the first and second members and effective to selectively move the members between the open and closed positions, see col. 12, lines 22-67 and figure 14.

Art Unit: 3739

Regarding claim 4, Tetzlaff et al. further disclose the first and second members are elongate and each member includes a proximal end mated to the actuating member, and a distal portion having the conductive element disposed thereon, see col. 10, line 36 through col. 13, line 43 and figures 12-14.

Regarding claim 10, Tetzlaff et al. disclose the claimed invention (see the insulative yoke, collectively 294, 296, 300, and 302 and the stop member 339), see col. 10, line 36 through col. 13, line 43 and figures 12-14.

Regarding claim 12, Tetzlaff et al. disclose the claimed invention, see col. 10, line 36 through col. 13, line 43 and figures 12-14.

Regarding claim 16, Tetzlaff et al. further disclose the tissue-contacting conductive surface of the first member has a surface area greater than a surface area of the tissue-contacting conductive surface of the second member, see col. 13, lines 1-12 and figure 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3739

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al. (USPN 6,511,480 B1) in view of Nezhat et al. (USPN 6,514,252 B2).

Regarding claim 6, Tetzlaff et al. disclose the claimed invention except for explicitly reciting that the first conductive element comprises first and second electrodes extending along the length of the distal portion of the first member and adapted to be positioned adjacent a tissue surface, and the second conductive element comprises a single electrode extending along the length of the distal portion of the second member and adapted to be positioned adjacent an opposed tissue surface between the first and second electrodes of the first member. Nezhat et al. disclose a bipolar forceps instrument and teach the use of a large number of alternate electrically conductive jaw surface configuration including one wherein the first conductive element (108) comprises first (100a) and second (100b) electrodes extending along the length of the distal portion of the first member and adapted to be positioned adjacent a tissue surface, and the second conductive element comprises a single electrode (102) extending along the length of the distal portion of the second member and adapted to be positioned adjacent an opposed tissue surface between the first and second electrodes of the first member, see col. 2-5, col. 10, lines 1-36 and figure 9D. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Tetzlaff et al., as taught by Nezhat et

al., to provide an alternate jaw surface configuration wherein the first conductive element comprises first and second electrodes extending along the length of the distal portion of the first member and adapted to be positioned adjacent a tissue surface, and the second conductive element comprises a single electrode extending along the length of the distal portion of the second member and adapted to be positioned adjacent an opposed tissue surface between the first and second electrodes of the first member.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al. (USPN 6,511,480 B1) in view of Swanson et al. (USPN 6,610,055 B1).

Regarding claim 9, Tetzlaff et al. disclose the claimed invention except for explicitly reciting that at least one of the first and second members is malleable. Swanson et al. disclose an electrosurgical forceps device and teach “the forceps-like apparatus 150 includes arms 154 and 156 that are pivotably secured to one another by a pin 158 to allow the device to be opened and closed. The proximal portions of the arms 154 and 156 may be formed from rigid or malleable material. The arm distal portions 160 and 162, which are curved and support the tissue coagulation apparatus 152, are preferably formed from malleable material. This allows the arm distal portions 160 and 162 to be re-shaped by the physician as needed for particular procedures and body structures (note the dash lines in FIG. 21), see col. 16, line 63 through col. 17, line 10 and figures 21-25. Arms 154 and 156 are analogous to the first and second members. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the

invention of Tetzlaff et al., as taught by Swanson et al., to provide the first and second members in a malleable form in order to be re-shaped by the physician as needed for particular procedures and body structures.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 6-13, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection. **This action is NON-FINAL.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*

May 15, 2006

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER